

REMARKS

Claims 1-11 are pending in the present application. Claims 1, 6 and 11 were amended in this response to improve form. No new matter has been introduced as a result of the amendments. Favorable reconsideration is respectfully requested.

Claims 1-5 were rejected under 35 U.S.C. §102(e) as being anticipated by *Edholm* (US Patent 6,772,210). Claims 6-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Thorton* (US Patent 6,363,065) in view of *Edholm* (US Patent 6,772,210). Claim 11 was rejected under 35 U.S.C. §102(e) as being anticipated by *Gardell* (US Patent 6,298,062). Applicants respectfully traverse this rejections.

Regarding *Edholm*, the reference does not teach or suggest at least the features of “determining, via the connection controller, a gateway device of the communication network as a connection destination based on the transmitted logical address information” and “establishing a connection controlled by the connection controller between the terminal and the gateway device ... [and] determining, via the gateway device, a network-externally valid transport address which is assigned to the transmitted logical address information,” as recited in claim 1.

In contrast, *Edholm* teaches that the gatekeeper does not determine the gateway as the destination, i.e. endpoint, of the connection. Instead, the gatekeeper under *Edholm* relies on conventional mapping to relay connections (which may or may not include gateways) through the network (col. 5, lines 5-10). The calling VoIP device in *Edholm* typically obtains the (public) network address or address/port number pair for the called VoIP device directly or indirectly from the gateway 106. A request may be sent to the gateway 106 requesting the (public) network address for the called VoIP device. The request may be sent by the gatekeeper 112, in which case the gatekeeper 112 obtains the (public) network address for the called VoIP device from the gateway 106 and provides the (public) network address for the called VoIP device to the calling VoIP device, typically along with the gateway address. Alternatively, the request may be sent directly by the calling VoIP device (for example, after receiving the gateway address from the gatekeeper 112), in which case the calling VoIP device obtains the (public) network address for the called VoIP device directly from the gateway 106 (see col. 4, lines 61-66; col. 5, lines 39-41, 58-62; col. 9, lines 37-43).

As Edholm does not establish gateways as a destination point, it follows that Edholm does not establish a connection between the terminal and the gateway. While the gateway in Edholm exchanges messages between terminal and gateway for routing, this does not demonstrate that a connection is established, nor that the connection is controlled by the gatekeeper. The recited configuration in of claim 1 provides that the connection controller (gatekeeper) deems the gateway device to be the connection endpoint, so that the establishing of the connection between the terminal and the gateway can be carried out by means of usual gatekeeper operation (i.e. establishing connections between connection endpoints).

Moreover, the "public network address or address/port number for the called VoIP device" in Edholm is not a network-externally valid transport address, as recited in claim 1. Instead, the public network address or address/port number for the called VoIP device is only a valid transport address internal to in the public network. The public network is the internal network in terms of claim 1, since it is the network with the gatekeeper. Under the teaching of Edholm, the public network address or address/port number is created by the gateway for the called (network-external) VoIP device in order to identify that network-external device by means of a network-internal address (see e.g. col. 5, lines 5-26; col. 6, lines 15-31; col. 7, lines 26-41). Accordingly, the terminals of the public network can address external devices only in the same manner as internal devices by means of internal (public) addresses. In order to relay calls from internal terminals to external terminals the gateway translates from the internal public network addresses or address/port numbers (not valid in the private network) for the external terminals to the corresponding private addresses (valid in the private network) of the external terminals (see e.g. col. 7, lines 26-41). Correspondingly, the gateway allocates the public network address or address/port number for the called VoIP device not to the phone number (transmitted logical address according to claim 1) of the called VoIP device, but rather to the private address (valid in the private network) of the called VoIP device (see e.g. col. 5, lines 5-21, col. 6, lines 15-20, 41-61).

Accordingly, since Edholm fails to teach every limitation in claim 1, Applicants respectfully submit that the rejection is improper and should be withdrawn.

Regarding amended claim 11, Gardell fails to teach both interfaces as conforming to ITU-T Recommendation H.323, where the first packet-switched interface operates under a

gatekeeper-controlled H.323 mode, and the second packet-switched interface operates simultaneously in a non-gatekeeper H.323 mode. Gardell explicitly teaches that gateway 12 to PSTN 22 (see FIG. 1 and accompanying text) is not a packet-switched H.323 interface, but is a conventional circuit-switched network interface. Accordingly, since Gardell fails to teach every limitation of claim 11, Applicants respectfully submit that the rejection is improper and should be withdrawn.

Regarding claim 6, Thorton fails to teach a gateway device "that can be connected to a relaying communication network for converting logical address information that identifies network-external connection destinations into network-externally valid transport addresses for transporting data packets over the relaying communication network; wherein the gateway device is registered in the connection controller as a network-internal connection destination under logical address information that identifies a network-external connection destination, and the external connection destination in the gateway device is registered as a network-external connection destination under the logical address information." To this end, the Office Action relied on Edholm as purportedly teaching this feature. However, as was previously argued with respect to claim 1, Edholm does not teach this feature as well.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the Thorton and Edholm references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the

examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Regarding the Thorton reference, the disclosure is centered around providing VoIP services and QoS improvements to PSTN users utilizing VoIP technologies (see Abstract). In contrast, Edholm is wholly silent regarding the use of PSTN system, and makes no provision whatsoever for their use, and relies exclusively on an IP communications network. As such, there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine these references.

In light of the above, Applicants respectfully submit that claims 1-11 are both novel and non-obvious over the art of record. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-311) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

A handwritten signature in black ink, appearing to read "Peter Zura", written over a horizontal line.

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